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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/337,546	06/22/1999	SHIGEKI HIROOKA	35.G2410	9128
5514	7590	03/03/2004		
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
			EXAMINER NEURAUTER, GEORGE C	
			ART UNIT 2143	PAPER NUMBER 13
DATE MAILED: 03/03/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/337,546

Applicant(s)

HIROOKA, SHIGEKI

Examiner

George C Neurauter, Jr.

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,8,10-16,22,24-30,36 and 38-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 8, 10-16, 22, 24-30, 36, and 38-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-2, 8, 10-16, 22, 24-30, 36, and 38-40 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2, 8, 10-16, 22, 24-30, 36, and 38-40 are rejected under 35

U.S.C. 102(e) as being anticipated by Stockwell et al. (US Patent 6 072 942 A)

Regarding claim 1, Stockwell discloses an e-mail processing method (referred to throughout the specification as "filtering") comprising the steps of:

identifying a data type of each part included in a received e-mail, the received e-mail being a multi-part ("MIME") e-mail; determining whether each part included in the received email can be processed, in accordance with the identified data type of each part; (column 2, lines 25-28, specifically "analyzes the electronic mail message"; column 15, lines 10-20, specifically lines 14-19)

storing ("delivering") a part that can be processed, included in the received email, if it is determined in said determining step that the part can be processed (column 2, lines 25-28); and

deleting ("rejecting") a part that cannot be processed, included in the received email, if it is determined in said determining step that the part cannot be processed. (column 2, lines 25-28).

Regarding claim 2, Stockwell discloses a method according to claim 1, further comprising the step of:

registering data types that can be processed, in advance, wherein it is determining step that a part can be processed when the identified data type of the part coincides with a registered data type ("pattern recognition"; column 15, lines 10-20, specifically lines 14-19).

Regarding claim 8, Stockwell discloses a method according to claim 1, wherein a presence of a part that cannot be processed is notified to a user (column 16, line 66-column 17, line 10).

Regarding claim 10, Stockwell discloses a method according to claim 1, wherein, when it has been determined that a part cannot be processed, a subsequent process is selectable from a plurality of predetermined processes. (column 12, lines 24-47; column 16, lines 47-53; Figure 8B, item 860)

Regarding claim 11, Stockwell discloses a method according to claim 1, wherein a data type of a part that can be processed is a text. (column 15, lines 10-20, specifically line 17)

Regarding claim 12, Stockwell discloses a method according to claim 1, wherein a data type of a part that can be processed is an image. (column 15, lines 10-20, specifically line 17)

Regarding claim 13, Stockwell discloses a method according to claim 1, wherein identification of a data type is performed by analyzing the received email. (column 2, lines 25-28, specifically "analyzes the electronic mail message")

Regarding claim 14, Stockwell discloses a method according to claim 1, wherein a data type of a part is identified in said identifying step according to a reference character string specified based on a position of a predetermined character string in the received email (column 15, lines 14-19, specifically line 17).

Claims 15-16, 22, and 24-28 are rejected since these claims recite an e-mail processing apparatus that contain substantially the same limitations as recited in claims 1-2, 8, and 10-14 respectively.

Claims 29-30, 36, 38-40 are rejected since these claims recite a computer-readable storage medium storing control software for implementing an e-mail process that contain substantially the same limitations as recited in claims 1-2, 8, and 10, and 13-14 respectively.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 5 918 018 A to Gooderum et al;

US Patent 6 256 666 B1 to Singhal.

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5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C Neurauter, Jr. whose telephone number is 703-305-4565. The examiner can normally be reached on Monday-Saturday 5:30am-10pm Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gcn



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